

REMARKS

Claims 1-13 are now in the application. Claims 5-8 are directed to the elected species. Claim 13 is generic to the elected and non-elected species. Claims 1-4 and 9-12 are directed to non-elected species.

With respect to the Information Disclosure Statement that was filed on May 9, 2007, since one copy each of all of the references along with their English language abstracts were filed on May 9, 2007, attached is a Replacement Information Disclosure Statement pursuant to 37 CFR 1.97 (f). For some inexplicable reason, the PTO/SB/08a form appeared as a blank form as received by the USPTO via electronic filing. Not having the completed PTO/SB/08a form received in the USPTO was clearly inadvertent. Accordingly, attached is the form that was completed at that time for filing to complete the filing of that Information Disclosure Statement.

Claims 5-8 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 6,417,283 to Ikeda et al. (hereinafter referred to as US '283) or U.S. Patent application publication 2003/0105213 to Hayashi et al. (hereinafter referred to as US '213). The cited references fail to render obvious the present invention. As is clear from the present disclosure, and as recited in claims 5-8, the essence of the present invention resides in the use of the specified carbon black having a particle size of 15 to 40 nm, a nitrogen absorption specific surface area N_2SA of 60 to 200 m²/g and 8.5 to 13 in the rubber composition for a pneumatic tire.

As a result, the wet performance of the pneumatic tire can be improved (see the data of the viscoelasticity ($\tan \delta/E'$) in Tables I and II of the present application), without causing a deterioration in the productivity (see the data of the rheometer (T 95) in Tables I and II).

Neither US '283 nor US '213 remotely suggest the above recitations or properties achievable thereby. The carbon black employed according to the present invention differs completely and entirely from those used in US '283 nor US '213.

US '283 (Ikeda et al.) suggests a carbon black graft polymer in which the carbon black has a specific surface area of 30 - 70 m²/g and a dibutyl phthalate oil absorption capacity of 10 - 70 ml/100g is grafted in the surface thereof with the polymer chain, whereby the increase in the grafting between the carbon black and the polymer is intended. Contrary to this according to the present invention, since the surface activity of the carbon black is different, the tight bound rubber with the carbon black is not formed, whereby the modulus in the low strain region becomes lower as in the case of silica and, as a result, the wet performance can be improved (please see page 2, line 36-page 3, line 9 of the specification). This is completely absent in the above references.

However, US '283 neither discloses nor teaches the use of the carbon black having, among other things, a particle size of 15 - 40 nm and a pH of 8.5 - 13 for the pneumatic tire. Moreover, the improved wet performance, without causing problems in the productivity and conductivity achievable by the present invention is not even remotely suggested by US '283.

US '213 (Hayashi et al.) suggests a composite particle having an average particle size of 0.001 - 12.0 µm composing (a) a core white inorganic particle (e.g., silica), (b) a gluing pigment coat (e.g., alkoxysilane) and (c) a black pigment coat (e.g., carbon black). Although the list of the carbon blacks in paragraph [0231] includes the carbon black satisfying the claimed carbon black, among the others, US '213 is quite different from the present invention in the following points.

(I) The carbon blacks suggested in US '213 are used as the black pigment coat (c) for the composite particle.

(II) The use of the carbon black per se in the rubber composition for a pneumatic tire is not taught in US '213.

(III) The selective use of the specified carbon blacks from the many kinds of and possible carbon blacks in the list in [0231] of US '213 is not taught in US '213.

(IV) US '283 neither discloses nor teaches the use of the specified carbon black according to the present invention for the pneumatic tire having the improved wet performance, without causing problems in the productivity and conductivity.

Furthermore, the cited art lacks the necessary direction or incentive to those of ordinary skill in the art to render a rejection under 35 USC 103 sustainable. The cited art fails to provide the degree of predictability of success of achieving the properties attained by the present invention needed to have a rejection under 35 U.S.C. 103 sustained. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 187 USPQ 774 (CCPA 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 USC 103. See *KSR Int'l Co. v. Teleflex, supra*, *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923 (Fed. Cir. 1990), *In re Antonie*, 195 USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ 519 (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property can be ignored in determining patentability and comparing the claimed invention to the prior art. Along these lines, see *In re Papesch, supra*, *In re Burt et al*, 148 USPQ 548 (CCPA 1966), *In re Ward*, 141 USPQ 227 (CCPA 1964), and *In re Cescon*, 177 USPQ 264 (CCPA 1973).

In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

A two-month extension of time fee is due with this response. The Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 22-0185, under Order No. 21712-00052-US1 from which the undersigned is authorized to draw.

Dated: May 27, 2008

Respectfully submitted,

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